

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSE M. RODRIGUEZ FERRE

Appeal No. 96-1608
Application 08/220,462¹

HEARD: JANUARY 11, 1999

Before ABRAMS, STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jose Manuel Rodriguez Ferre appeals from the final rejection of claims 3, 7, 9, 10, 12 and 14 through 16, all of

¹ Application for patent filed March 31, 1994. According to appellant, the application is a continuation of Application 07/977,837, filed November 17, 1992, now abandoned.

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the claims pending in the application.² We reverse and enter new rejections of claims 3, 7, 9, 10, 12 and 14 through 16 pursuant to 37 CFR § 1.196(b).

The invention relates to an articulated skeletal frame for a doll. Copies of representative claims 9 and 10 appear in the appendix to the appellant's brief (Paper No. 25).

The references relied upon by the examiner as evidence of obviousness are:

Rapata	3,539,234	Nov. 10, 1970
Cotey et al. (Cotey)	4,268,991	May 26, 1981
Refabert	4,954,118	Sept. 4, 1990
Deichmann ³ (Dutch Patent Document)	35,744	Jun. 15, 1935

Claims 3, 9, 10, 12, 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deichmann in view of Rapata and Cotey, and claims 7 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deichmann in view of

² Claim 7 has been amended subsequent to final rejection.

³ An English language translation of this reference, prepared by the Patent and Trademark Office, is appended hereto.

Rapata, Cotey and Refabert.⁴

Reference is made to the appellant's brief (Paper No. 25) and to the examiner's answer (Paper No. 26) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

Deichmann, the examiner's primary reference, discloses an articulated doll having a head 1, an upper body 2, a lower body 3, overarms 4, 4', forearms 5, 5, hands 6, 6', upper legs 7, 7', lower legs 8, 8 and feet 9, 9'. Some of these parts consist of a pair of parallel plates bolted together in spaced relationship. These plate-like parts articulate with respect to one another via links 14 having ball-shaped ends 15, 15' frictionally received in recesses formed in the edges of the plates (see Figure 3).

As conceded by the examiner (see page 3 in the answer), the Deichmann doll does not meet the limitations in independent claims 9 and 10 relating to the spherical hollow helmet-shaped socket portion. These limitations require the

⁴ The examiner has withdrawn the 35 U.S.C. § 112, second paragraph, rejection of claim 7 set forth in the final rejection (see page 5 in the examiner's answer, Paper No. 26).

socket portion to include a single opening on a distal end thereof and a single semicircular recess formed in the single opening for receiving a section of a link shaft to facilitate a natural multidirectional movement of the members of the claimed structure with a primary movement in a single direction. The examiner's reliance on Cotey to overcome this deficiency is not well taken.

Cotey discloses a doll 10 having an articulated skeletal framework 12 whose components are joined to one another by complementary balls and sockets formed on adjacent component ends.

In the examiner's view, it would have been obvious to one of ordinary skill in the art to provide the Deichmann construction with sockets of the sort taught by Cotey to receive the ball-shaped ends 15, 15' of Deichmann's connecting links 14 "as obvious alternative structures and/or to provide a better fitting socket for the ball elements, and a less bulky skeleton for the doll" (answer, page 4). As for the

requirement in claims 9 and 10 that the socket portion include a single semicircular recess formed in the single opening for receiving a section of a link shaft to facilitate a natural multidirectional movement with a primary movement in a single direction, the examiner tacitly acknowledges that Cotey's sockets do not include such recesses. Nonetheless, the examiner submits that "Deichmann clearly discloses such a recess for the socket to allow the shaft portion #14 of the link to move therein to define the movement of the link as in appellant's structure" (answer, page 5).

The only suggestion for this highly selective combination of articulated joint features disclosed by Deichmann and Cotey stems from hindsight knowledge derived from the appellant's own teachings. The use of such hindsight knowledge to support a conclusion of obviousness is, of course, impermissible. Since Rapata and Refabert do not cure this shortcoming in the examiner's evidence of obviousness, we shall not sustain the standing 35 U.S.C. § 103 rejections of claims 9 and 10, or of claims 3, 7, 12 and 14 through 16 which depend therefrom.

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The following rejections are entered pursuant to 37 CFR § 1.196(b).

Claims 9 and 10, and claims 3, 7, 12 and 14 through 16 which depend therefrom, are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. In the present case, it is not clear what is meant by the recitations in the first clauses of independent claims 9 and 10 that all of the members are of a substantially cylindrical shape. The underlying disclosure lacks any apparent mention or showing of such shape. Thus,

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the metes and bounds of the claimed subject matter are indefinite.

Claims 9 and 10, and claims 3, 7, 12 and 14 through 16 which depend therefrom, are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the written description provision of this section of the statute.

The test for determining compliance with the written description provision is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id. Here, the disclosure of the application as originally filed would not reasonably convey to the artisan that the appellant had possession at that time of an articulated structure wherein all of the members are of a substantially cylindrical shape as is now recited in the first

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clauses of independent claims 9 and 10.

In summary:

a) the decision of the examiner to reject 3, 7, 9, 10, 12 and 14 through 16 under 35 U.S.C. § 103 is reversed; and

b) new rejections of 3, 7, 9, 10, 12 and 14 through 16 are entered pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the

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application will be remanded to the examiner. . . .

(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b)

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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JOHN P. McQUADE)	
Administrative Patent Judge)	

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